

art, to modify the references or to combine reference teachings. MPEP §2142, §2143; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present application, the Examiner's obviousness rejection is improper because the Examiner has not established that the references teach or suggest all the claim limitations, nor has the Examiner established that one skilled in the art would be motivated to modify or combine reference teachings to arrive at the claimed invention. Accordingly, the Examiner's obviousness rejection is improper and should be withdrawn.

Claims 1-3

Claims 1-3 are directed to nut spreads having particular ratios of protein to fat. Thus, in order to establish a *prima facie* case of obviousness in the present case, the Examiner must show that Meade in combination with Composition of Foods teaches or suggests a nut spread having the recited ratios of protein to fat. This the Examiner has not done.

The Examiner states that Meade discloses a nut spread containing defatted roasted peanuts having a certain fat content, a certain solids to oil ratio, and a defatted roasted nut flour having a certain fat content. (12/17/02 Office Action, p. 2) Furthermore, the Examiner states that Composition of Foods discloses that nuts contain a particular amount of oil, a certain ratio of protein to oil, and that defatted peanut flour has a certain ratio of protein to oil. (12/17/02 Office Action, p.2)

However, neither Meade nor Composition of Foods teaches or suggests the protein to fat ratio required by the nut spread of the present invention. As noted by the Examiner in reference to Meade, "Claims 1-3 differ from the reference in the particular ratio of protein to fat." (12/17/02 Office Action, p. 2) The Examiner does not explain why, based upon these disclosures, the claimed ratio is nonetheless taught or suggested.

The Examiner has not pointed to any reference teaching that would motivate one skilled in the art to combine or modify the references in such a way that all required claim elements result. The Examiner states that "it would have been obvious to use ingredients in a product with various amounts of fat and protein depending on the ratio of ingredients desired." (12/17/02 Office Action, p.2, *emphasis added*) However, the Examiner does not give any reasons why one would desire to make a nut spread having the claimed properties. Because the Examiner has not explained why one skilled in the art would be motivated to make a nut spread having the claimed characteristics in view of the cited references, the conclusion of obviousness is without merit. Accordingly, because the *prima facie* case of obviousness has not been established, the rejection is improper and should be withdrawn.

Claims 4-7

Claims 4-7 are directed to nut spreads having particular fiber to fat ratios. Thus, in order to establish a *prima facie* case of obviousness in the present case, the Examiner must

show that Meade in combination with Composition of Foods teaches or suggests a nut spread having the recited ratios of fiber to fat. This the Examiner has not done.

The Examiner states that Meade discloses the use of inulin in various amounts, and that "it would have been obvious to vary the amounts because the use of inulin in spreads is known." (12/17/02 Office Action, p. 3) However, the Examiner does not explain, based upon this disclosure and that of Composition of Foods, how the claimed fiber to fat ratio is taught or suggested. The mere fact that an individual component may be present is not a sufficient explanation for why one would choose that component in combination with another in a certain ratio.

The Examiner states that "the effect of adding inulin to a composition to a peanut spread is known as shown by this reference." (12/17/02 Office Action, p.3) However, the Examiner does not state that the effect of adding fiber in a certain ratio with fat is known. What is claimed is the ratio of fiber to fat, not fiber in a certain amount alone. Furthermore, the Examiner does not explain why one would be motivated to modify the references to achieve the claimed ratio. Accordingly, the Examiner has not established the *prima facie* case of obviousness and the rejection should be withdrawn.

Claims 8-13 and 19-30

Claims 8-13 and 19-30 require various ratios and amounts of fiber, fat, and protein. Thus, in order to establish a *prima facie* case of obviousness in the present case, the Examiner must show that Meade in combination with Composition of Foods teaches or suggests a nut spread having the recited ratios and amounts of fiber, fat, and protein. This the Examiner has not done.

The mere fact that various components may be present in certain amounts is not sufficient explanation for why one would choose certain components in the claimed amounts and combinations with others. Thus, the Examiner has not established that the cited references teach or suggest the claimed invention.

Furthermore, the Examiner states that it would have been within the skill of the ordinary worker to vary the amounts of protein, fat, and fiber and that it would have therefore been obvious to make the claimed product. (12/17/02 Office Action, p. 3) That one skilled in the art could have made the invention does not explain why one skilled in the art would have been motivated to combine and modify the references to arrive at the claimed invention. Thus, the Examiner has not established the *prima facie* case of obviousness and the rejection should be withdrawn.

Claims 14-18

Claims 14-18 further require that the nut spreads comprise less than about 20% fat. The Examiner states that Meade discloses the use of liquid low calorie oil in amounts of 6%, and therefore it would be obvious to use the claimed amount of fat in the composition.

(12/17/02 Office Action, p. 3) It is respectfully pointed out to the Examiner that peanuts inherently contain fat, thus it would not necessarily follow that adding 6% low calorie oil would result in a nut spread comprising less than 20% fat, since this ignores the fat that is inherently present. Thus, the Examiner has not provided sufficient reasoning why the references teach or disclose the required fat levels. Furthermore, the Examiner has not explained why one would nonetheless be motivated to modify the references to achieve the claimed fat level in combination with the properties recited by the claims from which 14-18 depend. Accordingly, the Examiner has not established the *prima facie* case of obviousness and the rejection should be withdrawn.

Claims 31 and 32

Claims 31 and 32 require particular amounts of protein, wherein at least about 75% of the protein is from nut solids. The Examiner states that "Meade discloses the use of about 47% nut solids in using defatted nuts, roasted peanuts and nut flour," thus it would have been obvious to use the claimed amount of protein from nut solids. (12/17/02 Office Action, p. 3)

The mere fact that various components may be present in certain amounts is not sufficient explanation for why one would choose certain components in the claimed amounts and combinations with others. Thus, the Examiner has not established that the cited references teach or suggest the claimed invention. Furthermore, the Examiner has not explained why one would nonetheless be motivated to make a nut spread having the claimed properties, in view of the cited references. Without such a reason, the Examiner has not established the *prima facie* case of obviousness and the rejection should be withdrawn.

Claims 33-48

Claims 33-48 further require that the nut spread have a monomodal particle size distribution and specific recited particle sizes. The Examiner cites Meade for a particle size distribution that is not within the claimed range, but states that it would have nonetheless been within the skill of the ordinary worker to make particles of the required size, since the science of particle size is well developed. (12/17/02 Office Action, p. 3) Furthermore, the Examiner states in reference to particle size that it would have been obvious to choose whatever particle size that would have made the claimed composition. (12/17/02 Office Action, p. 4)

The mere fact that a reference may discuss particle size does not explain, however, how the reference teaches or suggests the recited particle size distribution, much less a nut spread having the recited particle size distribution in combination with all the limitations of the claims from which claims 33-48 depend. The Examiner has not explained why one skilled in the art would have been motivated to make a nut spread having the claimed properties, in view of the references. Absent such a reason, the Examiner has not established the *prima facie* case of obviousness and the rejection should be withdrawn.

Claims 49-50

Claims 49 and 50 further require that the nut spread have a particular number of calories. The Examiner states that Meade discloses a certain calorie level, thus it would have been obvious to vary the ingredients in order to achieve a particular amount of calories in a product. (12/17/02 Office Action, p. 4) This rationale does not explain, however, how the references teach or suggest the recited number of calories, much less a nut spread having the recited number of calories in combination with all the limitations of the claims from which claims 49-50 depend. Accordingly, the Examiner has not established the *prima facie* case of obviousness and the rejection should be withdrawn.

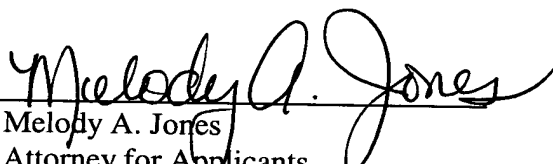
Claims 51-64

The Examiner states that claims 51-64 are rejected for the same reasons as discussed in reference to the other claims. Accordingly, for the same reasons as discussed in reference to claims 1-50 above, the Examiner's conclusion of obviousness should be withdrawn because the *prima facie* case of obviousness has not been established.

CONCLUSION

The Examiner is respectfully requested to reconsider the Application in view of the foregoing remarks. The Examiner bears the initial burden of supporting any *prima facie* conclusion of obviousness. MPEP §2142. Because this burden has not been met, the Examiner is respectfully requested to allow all claims as patentable.

Respectfully submitted,
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